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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,119	02/05/2004	Guido Desie	27500-197	3253

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EXAMINER	
NATALINI, JEFF WILLIAM	
ART UNIT	**PAPER NUMBER**
2858	

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/773,119	DESIE ET AL.	
	Examiner	Art Unit	
	Jeff Natalini	2858	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Huizinga et al. (4328280).

Huizinga et al. discloses an apparatus for evaluating the triboelectrical (col 1 line 6-8) properties of at least two samples (col 7 line 62 - col 8 line 3), comprising: a grounded means for holding a material in sheet form comprising a support provided on at least one surface thereof (col 8 line 4-5; the samples were held on a Stati-tester which is known in the art to be grounded as it provides a known charge, if it is not properly grounded, the known charge would be inaccurate) with at least two samples each in at least one predefined region thereof (col 7 line 62 – col 8 line 3; interpreted in the broadest sense, one piece of film is divided into three portions/sections for testing of different coatings, so they would all be kept together in one piece just divided into three sections, therefore three samples would be in the predefined region); a charging means for tribocharging said at least two samples (col 8 line 4-5); and a means for measuring an electrical property of said at least two samples (col 8 line 6-13 and table 2).

In regard to claim 2, Huizinga et al. discloses wherein the two samples comprise one test sample and at least one internal reference sample (col 7 line 62 - col 8 line 3).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-9 and 13-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abramsohn et al. (6166550) in view of Huizinga et al. (4328280).

In regard to claims 1 and 2, Abramsohn et al. discloses an apparatus for evaluating the triboelectrical properties of a sample (col 1 line 3-5), comprising: a grounded means (col 15 line 59-60; system is grounded) for holding a material in sheet form comprising a support provided on at least one surface thereof with a sample in at least one predefined region thereof (col 13 line 11-20; fig 1 shows sheet (sample-262) supported by drum-264); a charging means for tribocharging the sample (col 13 line 18-20); and a means for measuring an electrical property of the sample (col 15 line 23-25).

Abramsohn et al. lacks wherein two samples are evaluated and wherein one sample is a test sample and the other is a reference sample.

Huizinga et al. teaches wherein two samples triboelectric charge is evaluated and wherein one sample is a test sample and the other is a reference sample (col 7 line 62 – col 8 line 3), so that at least two samples would be in a predefined region (col 7 line 62 – col 8 line 3; interpreted in the broadest sense, one piece of film is divided into three portions/sections for testing of different coatings, so they would all be kept

together in one piece just divided into three sections, therefore three samples would be in the predefined region).

It would have been obvious to one with ordinary skill in the art at the time the invention was made for Abramsohn et al. to evaluate at least two samples, where one sample is a test sample and the other is a reference sample in order to determine the effect of surface treatment of films (col 8 line 30-40).

In regard to claims 3 and 13, Abramsohn et al. discloses wherein the sample is located on a rotatable drum (fig 1 (264); col 14 line 46-50).

In regard to claims 4-5, and 14-17, Abramsohn et al. discloses means for performing calculations on measured electrical property, where the means is a computer (col 15 line 35-42; also see fig 3).

In regard to claims 6 and 18-21, Abramsohn et al. discloses: a grounded (col 15 line 59-60; system is grounded) rotatable drum for holding the support in sheet form (fig 1 (264); col 14 line 46-50); a charging roller covered with a triboelectric reference material (col 16 line 4-6, the bias charged device roll would consist of a triboelectric reference col 14 line 46-57); a measuring probe connected to a voltmeter for measuring electrostatic potentials (col 10 line 58-64); a computer for handling incoming data (col 35-42).

Abramsohn et al. lacks specifically stating that the computer also outputs data (controls), but Abramsohn et al. discloses a controller (fig 2 304) to control many operations of the apparatus (col 17 line 30-37)- provide output signals.

It would have been obvious to one with ordinary skill in the art at the time the invention was made for Abramsohn et al. to combine into the computer (known input/output capability) the tasks of the controller in order to have single means for running all the input and output of the system and because MPEP 2144.04 V B *In re Larson*, 340 F.2d 965, 968 144 USPQ 347, 349 (CCPA 1965) states making integral does not provide patentable distinction.

In regard to claim 7, Abramsohn et al. as modified as seen in claim 6, to have the controller operations integrated into the computer, has software of a computer will control the rotation speed of the drum and the linear translation speed of the measuring means for measuring said electrical property across said support on the sheet (col 17 line 30-37; the computer is programmed to do these tasks, the programming being the software).

In regard to claims 8, 9, and 22-27, Abramsohn et al. discloses where the apparatus has a means for post-treatment, wherein the post-treatment comprises a printing means (col 6 line 52-65).

5. Claims 10-12 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abramsohn et al. (6166550) in view of Vanmaele et al. (EP 1243409).

In regard to claim 10, Abramsohn et al. discloses a method for evaluating the triboelectrical properties of a sample (col 1 line 3-5), comprising: a grounded means (col 15 line 59-60; system is grounded) for holding a material in sheet form comprising a support provided on at least one surface thereof with a sample in at least one

predefined region thereof (col 13 line 11-20; fig 1 shows sheet (sample-262) supported by drum-264); a charging means for tribocharging the sample (col 13 line 18-20); and a means for measuring an electrical property of the sample (col 15 line 23-25).

Abramsohn et al. lacks wherein an array of samples are evaluated and therefore lacks measuring sequentially the charge of the array of samples.

Vanmaele et al. teaches variants of multi-layered materials including film (pg 2 line 43-49) that are screened for useful electric properties by presenting an array of various coated materials (pg 2 line 57 – pg 3 line 6).

It would have been obvious to one with ordinary skill in the art at the time the invention was made for Abramsohn et al. to use an array of samples while evaluating properties of the material as taught by Vanmaele et al. in order to scan for useful properties in several variants of multilayered materials (pg 2 line 57-58), also with the addition of the array of samples, since Abramsohn et al. discloses a single voltmeter with a probe, measurements must be done sequentially, as only one sample can be measured at a time.

In regard to claim 11, Abramsohn et al. discloses where the apparatus has a means for post-treatment, wherein the post-treatment comprises a printing means (col 6 line 52-65).

In regard to claim 12, Abramsohn et al. contains wherein statistical calculations are performed on the samples (fig 3).

Abramsohn lacks wherein the samples are in an array so that each different sample is present in at least two rows and two columns.

Vanmaele et al. teaches variants of multi-layered materials including film (pg 2 line 43-49) that are disposed in an array (pg 2 line 57 – pg 3 line 6; figs 2 and 3). It would have been obvious to one with ordinary skill in the art at the time the invention was made for Abramsohn to have different test samples present in at least two columns and two rows as taught by Vanmaele in order to scan for useful properties in several variants of multilayered materials (pg 2 line 57-58).

Response to Arguments

6. In regard to claims 1-9 and 13-27, applicant argues mainly that the teaching is not able to test multiple samples at the same time. This testing multiple samples "simultaneously" or at the same time is not claimed. Instead it is claimed that two samples are on a sample in a predefined region of the sample. Huizinga et al. (the reference used as the main reference in the novelty rejection (102) or the teaching reference of the obviousness rejection (103)) teaches this feature, as there is one piece of film that is made into three different samples, one untreated and two control samples (col 7 line 62 – col 8 line 3; interpreted in the broadest sense, one piece of film is divided into three portions/sections for testing of different coatings). This piece of film would be placed on a support whereas the three samples would be tested. This testing may be done independently as explained by the applicant in these remarks. The teaching of Huizinga et al. still reads on the claims as stated, since there is no point in any of the claims where it is stated the tribocharging of the at least two samples is done

at the same time (simultaneously) and the measuring of an electrical property of the at least two samples is done at the same time (simultaneously).

In regard to claim 10-12 and 28, it is admitted that Abramshohn et al. lacks an array of samples, and uses the teaching of Vanmaele et al. to make up for this deficiency. Vanmaele et al. teaches testing multi-layered materials including film (pg 2 line 43-49) for useful electric properties by presenting an array of various coated materials (pg 2 line 57 – pg 3 line 6).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hajduk et al. (6690179) describes a method for screening an array of materials for properties which can consist of applying a charge.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Natalini whose telephone number is 571-272-2266. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Lefkowitz can be reached on 571-272-2180. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeff Natalini

ANJAN DEB
PRIMARY EXAMINER